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United States Patent and Trademark Office
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KQDA & ANDROLIA
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LOS ANGELES CA 90067-2983

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JUL 17 2006

OFFICE OF PETITIONS

In re Application of
Setoguchi
Application No. 09/319,670
Filing Date: 17 June, 1999
Attorney Docket No.: 108A-2851-PC

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DECISION

This is a decision on the petition filed on 24 April, 2006, apparently seeking withdrawal of the holding of abandonment under 37 C.F.R. §1.181, although Petitioner expressly seeks revival of the application (apparently under 37 C.F.R. §1.137), without stating his statutory basis(es).

For the reasons set forth below, the petition considered under 37 C.F.R. §1.181 is **DISMISSED**; the petition as considered under 37 C.F.R. §1.137(b) is **DISMISSED**; and the petition as considered under 37 C.F.R. §1.137(b) is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

(If Petitioner is unable to present even a satisfactory showing to support a petition under 37 C.F.R. §1.137(a), and Petitioner's only alternative will be to file a petition under 37 C.F.R. §1.137(b).)

- (2) Thereafter, there will be no further reconsideration of this matter.¹

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 6 November, 2001, with reply due absent extension of time on or 6 February, 2002;
- the instant application went abandoned after midnight 6 February, 2002;
- the Office mailed a Notice of Abandonment on 2 July, 2002;
- on 24 April, 2006, Petitioner filed the instant petition alleging non-receipt and sets forth an extended averment of attempts to inquire and an averment that he is unable to access the instant application online—notably, however, while Petitioner avers Notice to the Office regarding a changed of address in 2001, Petitioner makes no showing whatsoever that the Office received said Notice;
- moreover, Petitioner acknowledges receipt of a response to his January 2001 Status Inquiry indicating that an Office action was expected to be mailed by January, 2002—as noted above, it actually was mailed in November 2001—and Petitioner is unable to document Office receipt of another Status Inquiry until April 2006, which Petitioner avers was a fifth inquiry notwithstanding the absence of evidence of Office receipt of other averred inquiries.

Copies, *inter alia*, of the 6 November, 2001, non-final Office action and drawings requirements are enclosed herewith.

Petitioner's recitation of events almost suggests a mechanical tossing of papers at the Office without due diligence to determine receipt of the papers or inquire as to the Examiner to be contacted regarding the application.

Further, Petitioner complains that he is unable to access the application online, but never

¹ For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

evidences due diligence as to associating a customer number with the application in question to make possible such practice.

While the provisions of 37 C.F.R. §1.181 require that the regulation be invoked within two (2) months of the event complained of (i.e., the abandonment), Petitioner waited more than 50 months after abandonment and 45 months after Notice thereof to seek relief under the regulation.

Petitioner avers that non-receipt of the Office action in question. However, what is clear is that Petitioner changed addresses and there is no evidence that the Office received advance Notice as required.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁴

Delays in responding properly raise the question whether delays are unavoidable.⁵ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁶ And the Petitioner must be diligent in attending to the matter.⁷ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

-
- (1) Holding certain facts to have been established;
 - (2) Returning papers;
 - (3) Precluding a party from filing a paper, or presenting or contesting an issue;
 - (4) Imposing a monetary sanction;
 - (5) Requiring a terminal disclaimer for the period of the delay; or
 - (6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁵ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁶ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁷ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁸⁾⁾

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁹

Further, the commentary at MPEP §711.03(c) provides:

* * *

**A. Petition To Withdraw Holding of Abandonment Based on Failure To
Receive Office Action**

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

⁸ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁹ See: *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

* * *

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)

* * *

And the regulation (37 C.F.R. §1.181¹⁰) requires that relief be sought within two (2) months of the act complained of.

¹⁰ The regulations at 37 C.F.R. §1.181 provide:

§ 1.181 Petition to the Director.

◇

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

Thus, as of this writing Petitioner appears not to have satisfied and not to be able to satisfy the “showing” or “timeliness” requirements described above.

As to the Allegations
of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

As of this writing Petitioner has not satisfied the “reply,” “fee” and “showing/statement” requirements of the regulation.

As to the Allegations
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

As of this writing Petitioner has not satisfied the “reply,” “fee” and “showing/statement” requirements of the regulation.

CONCLUSION

Because it appears that Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**; the petition as considered under 37 C.F.R. §1.137(a) is **dismissed**; and the petition as considered under 37 C.F.R. §1.137(b) is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:¹¹

¹¹ On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The old FAX number no longer is in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

By mail: Commissioner for Patents¹²
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Encl: 6 November, 2001, non-final Office action and drawings requirements
2 July, 2002, Notice of Abandonment

¹² To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/319,670 06/17/99 SETOGUCHI

R 108A-2851-PC

EXAMINER

TM02/1106

KODA & ANDROLIA
10100 SANTA MONICA BOULEVARD
SUITE 2340
LOS ANGELES CA 90067

QUILLEN, A

ART UNIT

PAPER NUMBER

2671

DATE MAILED:

11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/319,670

Applicant(s)

SETOGUCHI, RYOZO

Examiner

Allen E. Quillen

Art Unit

2671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-3 have been cancelled, while claims 4-6 are pending.

Drawings

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. **Correction of Informalities -- 37 CFR 1.85**

New formal drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability.

Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. **Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

Claim Objections

1. Claims 4-6 are objected to because of the following informalities: the multiple uses of alternative language, i.e, the term "...and/or..", renders the claims uncertain with respect to the scope of each claim. Interpreting to the broadest meaning of the claimed invention, the Examiner presumes the term "...and/or..." means that either case is appropriate or that both cases are appropriate. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being a hybrid type claim, claiming multiple categories. Both a product of manufacture, i.e., an apparatus ("...a parallel processing device for generating a shape...") and a process of using a product, i.e, a method ("...and a process by said shape engine..") are described in claim 5. Limit each claim to only one statutory class of invention at one time. (Reference Ex parte Lyell, 17 USPQ2d_1548 (BPAI 1990)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,967,392 to Werner, et al.

3. Regarding claim 5, Werner discloses a parallel processing device for generating a shape and/or displaying an image (column 2, lines 20-38; column 3, line 5; column 3, lines 32-46; column 33, line 34), wherein a (“the cube”, column 8, line 9) shape engine (column 7, lines 60, “a structure”, through column 8, lines 1-31) which is a machine that creates and displays a 3D shape and/or a 2D shape is used for a geometric engine and/or a graphic engine, and a process by said shape engine and/or said geometric engine and/or said graphic engine (Figure 1, elements 4, 6, 22, column 7, lines 4-66) is executed according to a parallel and/or sequential processing step; characterized in that each of said engines is operated and controlled based on an organization composing level or a target shape generating level (Figure 1, element 2, column 7, lines 5-6, 9-10) using a geometric relation between a composed triangle or a composing triangle (Figures 6a-b, 7a-b, column 8, lines 1-30; column 15, lines 57-67).

4. Regarding claim 6, as described in claims 5 above, additionally Werner discloses a

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parallel processing device for generating a shape and/or displaying an image comprising: a geometric engine provided with an arithmetic unit (Figure 2, Figure 3, element 6, Figure 5, element 110, column 13, line 58) which operates according to a combinatory relation between a vertex and an edge (Figure 10, column 22, lines 26-31) of a given triangle for geometrically changing data of a 3D shape and/or a 2D shape which are formed by a shape generating machine (column 8, lines 62-67) ; a graphic engine provided with an arithmetic unit which operates according to a combinatory relation between a vertex and an edge of the given triangle for processing and/or displaying data of a 3D shape and/or a 2D shape which are changed by said geometric transforming machine(column 24, lines 23-29; 55-56); characterized in that said geometric engine and/or said graphic engine are/is installed in said parallel processing device (Figures 2, 3, 5, column 3, line 26-36; column 9, lines 48-65 through column 10, lines 1-12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Werner, and further in view of U.S. Patent 5,771,341 to Huddy and the paper by Sims, "Particle Animation and Rendering Using Data Parallel Computation," Computer Graphics, Vol. 24, Number 4, pp. 405-413, August, 1990.

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5. Regarding claim 4, Werner discloses a parallel processing device for generating a shape and or displaying an image (column 2, lines 20-38; column 3, line 5; column 3, lines 32-46; column 33, line 34) wherein a sequential and/or simultaneous parallel process (column 3, lines 26-30) is carried out on a shape engine and/or a geometric engine and/or a graphic engine (Figure 1, elements 2, 4, 6, 22, column 7, lines 4-45), which are displaying machines that create a three dimensional (3D) shape and/or a two dimensional (2D) shape (column 8, lines 62-67), characterized in that 4^n ($n=0, 1, 2$, column 11, lines 1-8) each of said engines are provided, wherein n is a numerical number (column 10, lines 13-15, 64-65) which shows the organization composing level (column 10, line 15-16, "organized in scanlines") and the minimum value is 0.

Werner does not teach the number of processors is a function of the shape generating level of a curved body surface. Huddy discloses 2D and 3D display of curved surfaces at any desired resolution (Abstract; Figure 2, Column 3, lines 41-45, 50-53, lines 64 through column 4, lines 1-12).

Huddy does not teach the number of processors is a function of this detailed level of division of curved body surface. Sims teaches varying the number of processors as a function of the shape depending on the number or data elements for displayed particles (Abstract; page 405, left side, lines 6-8; page 405, right side, lines 1-12; Figure 3, page 409, left side, lines 1-8, 20-22).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to allocate processors according to the level of detail as taught by Sims and Huddy in combination with the organizing composing level as Werner discloses. The motivation for this combination includes (1) "the creation of complex structures and motion from a relatively brief abstract description" (Sims, page 405, left side, lines 21-26), (2) rendering speed is

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approximately proportional to the number of processors, and (3) permits computer animation of complex structure and motion automatically using data parallelism as more powerful, parallel computers become widely available, (Sims, under section labeled "Conclusion," lines 21-22, page 412, left side; lines 25-31). One of ordinary skill in the art of graphics processing would have been motivated to do make these obvious combinations, and it is therefore not patentable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen E. Quillen whose telephone number is 703 605 1231. The examiner can normally be reached Tuesday-Friday's from 7am to 4:30pm .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Zimmerman, can be reached on 703 305 9798.


Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: 703 872 9314 (for Technology Center 2600 only)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


**MARK ZIMMERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**

PTO/SB/06A (10-96)

Approved for use through 10/31/99. OMB 0551-0001

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Group 2700

FOREIGN PATENT DOCUMENTS

**Examiner
Signature**

Date
Cons

Oct. 16, 2001

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicable to place a check mark here if English language Translation is attached.

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Substitute for form 1449B/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet 2 of 2

Complete if Known

Application Number	09/319,670
Filing Date	June 7, 1999
First Named Inventor	Ryozo Setoguchi
Group Art Unit	2774
Examiner Name	n/a
Attorney Docket Number	108A 2851 PCT

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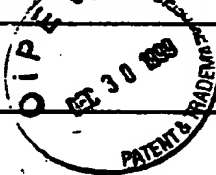
JAN 4 - 2000

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.

Group 2700

Examiner Initials ¹	Cite No. ¹		T ²
Q		Author: NORIYUKI SAGISHIMA Title: "PARALLEL GRAPHIC PROCESSING" Date: 1991	
Q		Pertinent Pages: 77-85 Place of Publication: Japan	
Q		Author: MINOBU ABE et al. Title: "PHOTO-REALISTIC IMAGE GENERATION SYSTEM FOR REALTIME ANIMATION"	
Q		Date: February 23, 1989 Pertinent Pages: 65-72 Place of Publication: Japan	
Q		Author: YOSHIKI TAMAMURA et al. Title: "GRAPHICS PROCESSING SYSTEM USING MULTI-PROCESSOR-BASED GRAPHIC COMPUTER- MAGIC"	
Q		Date: September 29, 1988 Pertinent Pages: 1-8 Place of Publication: Japan	



Examiner Signature	<i>A. S. White</i>	Date Considered	Oct. 16, 2001
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¹EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

² Unique citation designation number. ³ Applicant is to place a check mark here if English language Translation is attached.

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NOTICE OF DRAFTSPERSON'S
PATENT DRAWING REVIEWThe drawing(s) filed (insert date) 6/1/99 are:A. ☐ approved by the Draftsperson under 37 CFR 1.84 or 1.152.B. ☒ objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons indicated below. The Examiner will require submission of new, corrected drawings when necessary. Corrected drawing must be submitted according to the instructions on the back of this notice.

1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:
Black ink. Color.
Color drawings are not acceptable until permission is granted.
Fig(s) _____
Pencil and non black ink not permitted. Fig(s) _____
2. PHOTOGRAPHS. 37 CFR 1.84 (b)
1 full-tone set is required. Fig(s) _____
Photographs not properly mounted (must use bristol board or photographic double-weight paper). Fig(s) _____
Poor quality (half-tone). Fig(s) _____
3. TYPE OF PAPER. 37 CFR 1.84(e)
Paper not flexible, strong, white, and durable.
Fig(s) _____
Erasures, alterations, overwritings, interlineations, folds, copy machine marks not accepted. Fig(s) _____
Mylar, vellum paper is not acceptable (too thin). Fig(s) _____
4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:
21.0 cm by 29.7 cm (DIN size A4)
21.6 cm by 27.9 cm (8 1/2 x 11 inches)
All drawing sheets not the same size.
Sheet(s) _____
Drawing sheets not an acceptable size. Fig(s) _____
5. MARGINS. 37 CFR 1.84(g): Acceptable margins:
Top 2.5 cm Left 2.5cm Right 1.5 cm Bottom 1.0 cm
SIZE: A4 Size
Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm
SIZE: 8 1/2 x 11
Margins not acceptable. Fig(s) _____
Top (T) _____ Left (L) _____
Right (R) _____ Bottom (B) _____
6. VIEWS. 37 CFR 1.84(h)
REMINDER: Specification may require revision to correspond to drawing changes.
Partial views. 37 CFR 1.84(h)(2)
Brackets needed to show figure as one entity.
Fig(s) _____
Views not labeled separately or properly.
Fig(s) _____
Enlarged view not labeled separately or properly.
Fig(s) _____
7. SECTIONAL VIEWS. 37 CFR 1.84 (h)(3)
Hatching not indicated for sectional portions of an object.
Fig(s) _____
Sectional designation should be noted with Arabic or Roman numbers. Fig(s) _____
8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)
Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned so that the top becomes the right side, except for graphs. Fig(s) _____
9. SCALE. 37 CFR 1.84(k)
Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction.
Fig(s) _____
10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)
Lines, numbers & letters not uniformly thick and well defined, often, double, and black (poor line quality). Fig(s) 1-9
11. SHADING. 37 CFR 1.84(m)
Solid black areas pale. Fig(s) _____
Solid black shading not permitted. Fig(s) _____
Shade lines, pale, rough and blurred. Fig(s) _____
12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.84(p)
Numbers and reference characters not plain and legible.
Fig(s) _____
Figure legends are poor. Fig(s) _____
Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(1)
Fig(s) _____
English alphabet not used. 37 CFR 1.84(p)(2)
Fig(s) _____
Numbers, letters and reference characters must be at least .32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3)
Fig(s) _____
13. LEAD LINES. 37 CFR 1.84(q)
Lead lines cross each other. Fig(s) _____
Lead lines missing. Fig(s) _____
14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(t)
Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Sheet(s) _____
15. NUMBERING OF VIEWS. 37 CFR 1.84(u)
Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____
16. CORRECTIONS. 37 CFR 1.84(w)
Corrections not made from prior PTO-948 dated _____
17. DESIGN DRAWINGS. 37 CFR 1.152
Surface shading shown not appropriate. Fig(s) _____
Solid black shading not used for color contrast. Fig(s) _____

COMMENTS

REVIEWER JrDATE 9/22/91

TELEPHONE NO. _____

ATTACHMENT TO PAPER NO. 8

Notice of References CitedApplication/Control No.
09/319,670Applicant(s)/Patent Under
Reexamination
SETOGUCHI, RYOZOExaminer
Allen E. QuillenArt Unit
2671

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
	A	US-4,967,392	10-1990	Werner, et al	364	900
	B	US-5771341	06-1998	Huddy	395	119
	C	US-				
	D	US-				
	E	US-				
	F	US-				
	G	US-				
	H	US-				
	I	US-				
	J	US-				
	K	US-				
	L	US-				
	M	US-				

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification	
	N						
	O						
	P						
	Q						
	R						
	S						
	T						

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Karl Sims, "Particle Animation and Rendering Using Data Parallel Computation," August, 1990, ACM Press, Computer Graphics, Vol. 24, Number 4, NY, NY, pp. 405-413.
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,670	06/17/1999	RYOZO SETOGUCHI	108A-2851-PC	3430

7590

01/02/2002

KODA & ANDROLIA
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LOS ANGELES, CA 90067

EXAMINER

CHAUHAN, ULKA J

ART UNIT

PAPER NUMBER

2671

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Abandonment

Application No.

09/319,670

Examiner

Ulka J. Chauhan

Applicant(s)

SETOGUCHI, RYOZO

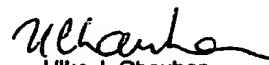
Art Unit

2671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 06 November 2001.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


Ulka J. Chauhan
Primary Examiner
Art Unit: 2671

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.